

REMARKS/ARGUMENTS

Claims 1-12, 16, 17, 19-30, 34-45, 49 and 50 are pending in the present application. Claims 1, 16, 19 and 34 have been amended herewith. Reconsideration of the claims is respectfully requested.

I. 35 U.S.C. § 112, Second Paragraph

Claims 1, 16, 19 and 34 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. This rejection is respectfully traversed.

In rejecting Claims 1, 16, 19 and 34, the Examiner states that the term ‘transaction result’ is unclear since it is not defined in the Specification. Applicants urge that every term in a claim does not have to be specially defined in the Specification, and absent a special definition provided in the Specification, claim terminology is to be interpreted according to its normal, plain meaning¹. Applicants urge that it is clear to those of ordinary skill in the art that the term ‘transaction result’ means a *result* of a transaction.

Further with respect to these Claims 1, 16, 19 and 34, the Examiner notes ambiguity with respect to the terminology ‘check from a user’. Applicants have amended such claims to remove this alleged ambiguity.

Therefore, the rejection of Claims 1, 16, 19 and 34 under 35 U.S.C. § 112, second paragraph has been overcome.

II. 35 U.S.C. § 103, Obviousness, Claims 1, 5-8, 16, 19, 23-26, 34 and 38-41

Claims 1, 5-8, 16, 19, 23-26, 34 and 38-41 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hyde, Jr. (U.S. Patent No. 6,038,553, hereinafter “Hyde”) in view of Cahill et al. (U.S. Patent No. 5,678,046, hereinafter “Cahill”) and further in view of Ozaki et al. (U.S. Patent No. 5,933,478, hereinafter “Ozaki”). This rejection is respectfully traversed.

With respect to Claim 1, such claim recites (i) transmitting the transaction result to the automatic teller machine and (ii) transmitting the image and the transaction result to a mobile device associated with

¹ During examination, the claims must be interpreted as broadly as their terms reasonably allow. *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1369, 70 USPQ2d 1827, 1834 (Fed. Cir. 2004). This means that the words of the claim must be given their plain meaning unless the plain meaning is inconsistent with the specification. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (discussed below); *Chef America, Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1372, 69 USPQ2d 1857 (Fed. Cir. 2004) (Ordinary, simple English words whose meaning is clear and unquestionable, absent any indication that their use in a particular context changes their meaning, are construed to mean exactly what they say. MPEP 2111.01(I) (emphasis added by Appellants).

the user. The Examiner expressly acknowledges that Hyde does not teach or describe “transmitting the image of the checks, the image of the user, and the transaction result”. However, the Examiner further states that Cahill teaches that check images are faxed to a payee’s fax machine, and therefore it would have been obvious to modify the teachings of Hyde to include faxing the cashing data captured according to Hyde (sic) because Cahill details the reasons it is desirable to archive electronic versions of checks. Applicants urge clear error in such rationale for making the Hyde/Cahill combination, as the Hyde user uses an automated teller machine (ATM) to input a check (Hyde col. 4, lines 54-57), and it is commonly known to those of ordinary skill in the art that such ATM devices do not have facsimile machines included therewith (also, see Hyde Figure 3 and col. 6, lines 15-32) – and thus there would be *no reason* to fax any type of information to the Hyde ATM as such ATM would have no ability to receive the fax information. Thus, a person of ordinary skill in the art would *not* have been motivated to modify the teachings of Hyde to include transmitting a fax in the Hyde teachings, as such facsimile transmission would be without effect, and thus pointless.

Still further with respect to this improper combination of the Hyde and Cahill references, there would have further been no reason to fax the scanned check image to Hyde’s ATM, as the Hyde ATM *already has an image of the check* since it created the scanned image of the check in the first place (Hyde col. 5, lines 3-5). Faxing a scanned image to the Hyde system, in addition to not even being physically possible, would serve no purpose other than to consume valuable communication bandwidth and data processing overhead as the scanned check information already resides in the Hyde terminal, and thus such modification would merely result in duplicative data having no legitimate purpose – strongly evidencing that there would have been no motivation to make such Hyde/Cahill combination.

In any event, Applicants have amended Claim 1 to further emphasize the synergistic qualities provided by the features recited therein, wherein the ATM device itself is used to update information in the user’s mobile device. None of the cited references teach or otherwise suggest such capability. Thus, in addition to Claim 1 having been erroneously rejected by an improper combination of references, it is further urged that Claim 1 is not obvious in further view of the present amendment to such claim.

Applicants initially traverse the rejection of Claims 5-8 for reasons given above with respect to Claim 1 (of which Claims 5-8 depend upon).

Further with respect to Claim 5 (and dependent Claim 6), it is urged that none of the cited references teach or suggest the claimed feature of “*sending an alert for the transaction to a plurality of users associated with an account*, the account being updated based upon the transaction result” (emphasis added). In rejecting Claim 5, the Examiner asserts that this missing claimed feature would have been obvious since it is old and well known that if the account has multiple names associated therewith, the statement will be sent to all accountholders. Applicants urge two-fold error in such assertion.

First, Claim 5 is not directed to sending a monthly statement to multiple users associated with an account, as is alleged to be old and well known, but instead is directed to sending an alert for the transaction itself to a plurality of users. Thus, the Examiner's position as to what is old and well known fails to properly establish a prima facie showing of obviousness².

Second, whether something is old and well known is not a proper test for obviousness – and since this is a stated reason for rejecting Claim 5 such rejection is clearly erroneous. As stated by the Federal Circuit, "virtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); see also *Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983) ("Most, if not all, inventions are combinations and mostly of old elements."). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996). To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 149 F.3d 1350, 47 USPQ 2d 1453 (Fed. Cir. 1998). "[w]hen determining the patentability of a claimed invention which combines two known elements, 'the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.'" See *In re Beattie*, 974 F.2d 1309, 1311-12, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992) (quoting *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984)). Therefore, the Examiner's reliance on something being old and well-known is clearly erroneous.

Thus, it is further shown that Claim 5 (and dependent Claim 6) has been erroneously rejected, as (i) a proper prima facie showing of obviousness has not been established by the Examiner, and (ii) the old and well-known assertion regarding obviousness is clear error.

² To establish prima facie obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. MPEP 2143.03 (emphasis added). See also, *In re Royka*, 490 F.2d 580 (C.C.P.A. 1974). If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

Further with respect to Claim 8, such claim recites “sending the image of the user with the image of the check to the mobile device”. Applicants urge that none of the cited references teach or suggest this claimed user-image-sending feature. In rejecting Claim 8, the Examiner states:

“Claims 7, 8, 35, 36, 40, 41, Hyde further teaches capturing an image of a user at an automated teller machine and stores the information along with both sides of the scanned check within the check cashing database.”

It is urged that such assertion does not establish a teaching or suggestion in the cited references of the particular features recited in Claim 8 with respect to a user-image-sending feature. Further on, the Examiner states:

“It would be an obvious next step to include the user picture which is stored along with the check images because of the security benefits obtained by maintaining the user’s image”.

Applicants urge numerous errors in such assertion, as follows.

First, this statement is pure subjective opinion by the Examiner, and not objective evidence, and therefore fails to meet up to the prima facie obviousness requirement expressly spelled out in the MPEP and extensive case law (as previously cited in footnote 2).

Second, the Examiner’s ‘reason’ for why it would be obvious is also faulty, as security benefits obtained by ‘maintaining’ a user’s image provides no motivation with respect to ‘transmitting’ a user’s image, as per the expressly recited features of Claim 8.

Thus, it is further urged that Claim 8 has been erroneously rejected due to this failure to properly establish a prima facie showing of obviousness with respect to such claim.

Applicants traverse the rejection of Claims 16, 19, 23-26, 34 and 38-41 for similar reasons to those given above with respect to Claim 1.

Applicants further traverse the rejection of Claims 23 (and dependent Claim 24) and 38 (and dependent Claim 39) for similar reasons to the further reasons given above with respect to Claim 5.

Applicants further traverse the rejection of Claims 26 and 41 for similar reasons to the further reasons given above with respect to Claim 8.

Therefore, the rejection of Claims 1, 5-8, 16, 19, 23-26, 34 and 38-41 under 35 U.S.C. § 103 has been overcome.

III. 35 U.S.C. § 103, Obviousness, Claims 2-4, 20-22, 35-37, 49 and 50

Claims 2-4, 20-22, 35-37, 49 and 50 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hyde, Jr. (U.S. Patent No. 6,038,553), in view of Cahill et al. (U.S. Patent No. 5,678,046), in view of

Ozaki et al. (U.S. Patent No. 5,933,478), as cited above, and further in view of “The XML Files”. This rejection is respectfully traversed.

Applicants initially traverse the rejection of these Claims 2-4, 20-22, 35-37, 49 and 50 for similar reasons to those given above with respect to Claim 1, as the newly cited “The XML Files” does not overcome the teaching/suggestion deficiencies identified hereinabove.

Further with respect to Claim 2, such claim recites “importing the image and the transaction result into an end-user financial program that is useable to manage finances for the user such that both (i) a current account balance for the user, which accounts for an amount indicated by the received check, and (ii) the image of the received check are accessible to the user using the end-user financial program”. In rejecting Claim 2, the Examiner alleges that the cited “The XML Files” reference discloses receiving a bank statement in a format which is easily imported into bank reconciliation software at page 76, col. 2, paragraph 3. Applicants urge error in such assertion, as this cited paragraph makes no mention of any import of data into bank reconciliation software. Instead, this cited passage merely states that a file can be imported ‘to update your files’. A description of updating files does not teach any type of bank reconciliation software, as alleged by the Examiner. In fact, this cited article goes on to state that this imported information is used to print the information by the use (page 76, column 2, paragraph 4). Even assuming arguendo that the reference does teach such a financial reconciliation program, that still does not establish a teaching/suggestion of importing BOTH (i) the image AND (ii) the transaction result into a end-user financial program that is usable to manage finances of the user such that both a current account balance for the user AND the image of the received check are accessible to the user using such program. Thus, Claim 2 is further shown to have been erroneously rejected due to this additional failure by the Examiner to properly establish a prima facie showing of obviousness.

Still further with respect to Claim 2, the Examiner again relies on things that are alleged to be “old and well known” in the rejection of Claim 2, which is clear error as previously described with respect to Claim 5.

Further with respect to Claim 49 (and similarly for Claim 50), it is urged that none of the cited references teach or suggest the claimed feature of “transmitting the image and the financial information from the mobile device to the another data processing system”. As can be seen, per the features of Claim 49 in combination with Claim 4 (of which Claim 49 depends upon) a mobile device is effectively used as a relay such that both the check image and transaction result are transmitted to the mobile device, and this mobile device transmits both the check image and transaction device to another data processing system for processing by a financial program at the another data processing system. The cited combination of references doesn’t teach/suggest transmitting, by a mobile device, of both the transaction result and the image that was received by the mobile device. Thus, Claim 49 (and similarly for Claim 50) is further

shown to have been erroneously rejected due to this additional failure by the Examiner to properly establish a prima facie showing of obviousness.

Therefore, the rejection of Claims 2-4, 20-22, 35-37, 49 and 50 under 35 U.S.C. § 103 has been overcome.

IV. Conclusion

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,

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